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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/650,362	08/29/2000	Julie J. Bennett	42390P9622	8226

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EXAMINER	
WONG, LESLIE	
ART UNIT	**PAPER NUMBER**
2164	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/650,362	BENNETT ET AL.	
	Examiner	Art Unit	
	Leslie Wong	2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 January 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,9-12,20-23 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,9-12,20-23 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 17 January 2007, is acknowledged.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 9-12, 20-23, and 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 1, 12, and 23 recite "allowing a user in communication with the visual browser to **non-explicitly select a main product**". This limitation appears to be conflicting with the Applicant's disclosure because the Specification states that the user has to pick a main product (i.e., explicit) before the browser can automatically presents related products.

Applicant's Response filed 23 February 2006 states:

Applicant has amended these claims to further clarify the embodiments of the invention. As set forth in Applicant's patent application on pages 11-12: "The visual browser of the present invention allows a user to navigate a virtual store hosted by an ISP, *without needing to express verbally what they are looking for (i.e. an explicit method), and instead provides non-explicit methods for virtual shopping*...In particular, after a user picks a main product, the visual browser automatically presents similar and related products, and also possibly non-related products, to the user providing opportunities for the user to view and possibly purchase these other related and non-related products." (Emphasis added).

Applicant's Specification page 11, lines 20-23 discloses:

The visual browser of the present invention allows a user to navigate a virtual store hosted by an ISP, without needing to express verbally what they are looking for (i.e. an explicit method), and instead provides non-explicit methods for virtual shopping. In particular, after a user picks a main product, the visual browser automatically presents similar and related products,

Further, Applicant's Specification page 14, lines 10-20 discloses:

Figure 3A is an example of a user interface 300 at a user's terminal computer displaying a main product and related products according to one embodiment of the invention. When a user logs on to a service provider having the visual browser of the present invention to engage in virtual shopping at the service provider's virtual store, the user is presented on the display of his/her computer with a user interface similar to that the Figure 3A. Of course the types of products shown, depend upon the type of virtual store and the products carried by that virtual store. Utilizing the visual browser of the present invention, when a user first enters the virtual store a random selection of items from the service provider's database of products is displayed as in Figure 3A. In this instance, a Deluxe Italian Basket 301 is randomly selected as the main product and is displayed in the main product space 302. Underneath the main product is a description of the main product and a price for the main product.

Based on the above, it appears that Applicant's invention does not enable (i.e., teach how to) the step of "non-explicitly" select a **main** product. Since "a user picks a main product" appears to be an explicit step, the claimed limitation "allowing a user in communication with the visual browser to **non-explicitly select a main product**" is inconsistent with Applicants' disclosure.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 9-12, 20-23, and 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 12, and 23 recites "allowing a user in communication with the visual browser to **non-explicitly select a main product**".

Applicant's Specification, page 11, lines 20-23, discloses the term "non-explicitly" is without needing to express verbally what they are looking for. Applicant's Response page 12, paragraph 4, states that "Currently, most e-commerce virtual shopping experiences rely on users explicitly knowing what they are looking for and describing it in verbal ways (i.e., an explicitly method)...For example, most virtual shopping through today's e-commerce websites requires a user to search for products by inputting verbal terms, going down through a multitude of different categories, ... or selecting various product attributes stored in a database to finally find a desired product." It is not

understood how the user can pick a **main** product without indicating or expressing or selecting what his/her desired product.

Claims 9-11, 20-22, and 31-33 are rejected for fully incorporating the deficiencies of their respective base claims by dependency.

Examiner's Remarks

7. For purpose of examination, Examiner interprets the limitation "allowing a user in communication with the visual browser to non-explicitly select a main product" as the user has to click on/select the item in order to select the MAIN product.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 12 and 20-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C 101.

Claims 12 and 20-22 appear to be non-statutory because the "machine-readable medium" as used herein can take the form of signal/carrier waves. Applicants' Specification, page 25, line 22 – page 26, line 10, discloses "...machine-readable medium transmitted by data signal embodied a carrier wave..."

> Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101.
>
> First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three § 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.
>
> See Interim Guidelines page 55, section **(c) Electro-Magnetic Signals.**

Applicants are suggested to amend the term "machine-readable medium" to "machine-readable **storage** medium" to include only volatile and non-volatile mediums in order to overcome the above 101 rejection.

The above 101 rejection was issued in Final Office Action sent 26 May 2006.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1, 9-12, 20-23, and 31-33 are rejected under 35 U.S.C. 102(e) as being anticipated by **Jacobi et al.** ("Jacobi") (U.S. Patent 6,317,722 B1).

Regarding claims 1, 12, and 23, **Jacobi** teaches a method and an apparatus comprising:

a). upon a user accessing a virtual store having a visual browser via a computer network, displaying a random assortment of graphical representations (col. 5, line 20) of products to the user associated with the virtual store (col. 5, lines 19-22 and 32-35);

b). creating a plurality of categories, each category identifying an attribute (col. 5, lines 32-35; col. 7, lines 5-7 and 14-17; col. 1, lines 16-22 and 46-49);

c). associating products (i.e. books, CDs, or videos) having at least one attribute with at least one category (i.e., non-fictions, comedies) (col. 2, lines 46-49);

d). allowing a user in communication with the visual browser to non-verbally select a main product (col. 5, lines 32-35; col.7, lines 5-7; and); and

e). upon the non-verbally selection of a main product, automatically displaying a plurality of related products having at least one attribute in common with the main

product that are selectable for purchase by the user (col. 3, lines 52-55; col. 10, lines 45 – 63; col. 7, lines 5-9; col. 4, lines 2-6; Fig. 2, element 94) and at least one other product that is not associated with the main product, the plurality of products being determined by (col. 4, lines 2-6):

1). assigning a weight bias to each category based upon a predefined importance of the respective category (col. 3, lines 23-27);

2). determining "like" and “dislike” categories for the main product, a "like" category being a category that the main product is associated with (col. 8, lines 60-63; col. 15, lines 58-62);

3). selecting one of the "like" and “dislike” categories includes utilizing the weight biases for the categories in a randomly based selection algorithm (col. 8, lines 28-39; col. 5, lines 19-31); and

4). randomly selecting products from the selected “like” and “dislike” categories (col. 5, lines 19-31).

Regarding claims 9, 20, and 31, **Jacobi** further teaches a step comprising:

a). scoring each product based upon weight biases of "like" categories (Fig. 5, element 180) and "dislike" categories (Fig. 5, element 190), a "like" category being a category that the main product is associated with, a "dislike" category being a category that the main product is not associated with, a weight bias being a predefined value assigned to each respective category to denote the respective category's importance (col. 8, lines 28-38);

b). creating a "like" score table, the "like" score table including a "like" score for each of the products indicating the relatedness of the product to the main product (Fig. 1, element 60); and

c). randomly selecting the at least one other related product from the "like" score table using the "like" scores as a weight bias (col. 12, lines 61-65).

Regarding claims 10, 21, and 32, **Jacobi** further teaches a step comprising:

a). creating a "dislike" score table, the "dislike" score table including a "dislike" score for each product indicating the unrelatedness of the product to the main product, the "dislike" score table being the transposition of the "like score table" (col. 8, lines 28-39); and

b). randomly selecting at least one other product from the "dislike" score table using the "dislike" scores as a weight bias (col. 5, lines 19-31).

Regarding claims 11, 22, and 33, **Jacobi** further teaches a step of selecting at least one other product at random from one of the plurality of categories (col. 5, lines 19-22).

Response to Arguments

11. Applicants' arguments filed 17 January 2007have been fully considered but they are not persuasive.

Applicants argue that Jacobi nowhere describes or suggests determining "like" or "dislike" categories for a main product and selecting "like and "dislike" categories utilizing weight biases for the categories in a randomly based selection algorithm, wherein weight biases are assigned to each category based upon a predefined importance of the respective category.

In response to the preceding arguments, Examiner respectfully submits that Jacobi teaches "determining "like" or "dislike" categories for a main product and selecting "like and "dislike" categories utilizing weight biases for the categories in a randomly based selection algorithm wherein weight biases are assigned to each category based upon a predefined importance of the respective category" as users of the BookMatcher service are provided the opportunity to rate individual book titles from a list of popular titles: 1=bad, 2=not for me...5=loved it! (col. 8, lines 28-38). The Amazon.com web site includes functionality for allowing users to search, browse, and make purchases from an online catalog of several million book titles, music titles, video titles, and other types of items ... a "shopping cart" is a data structure and associated code which keeps track of items that have been selected by a user for possible purchase (col. 5, lines 19-31). As such, Jacobi teaches the limitations as claimed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (571) 272-4120. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHARLES RONES can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Leslie Wong
Primary Patent Examiner
Art Unit 2164

LW
March 29, 2007